



PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the application of	)	
Naoki KUWATA et al.	)	Technology Division: 2625
Application No. 09/941,711	)	Examiner: James A. Thompson
Filed: August 30, 2001	)	Atty. Docket No. MIPFP005
For: APPARATUS, METHOD, SIGNAL AND	)	Date: January 17, 2007
COMPUTER PROGRAM PRODUCT	)	Confirmation No. 6245
CONFIGURED TO PROVIDE OUTPUT	)	
IMAGE ADJUSTMENT OF AN IMAGE	)	
FILE	)	

CERTIFICATE OF MAILING

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on January 17, 2007.

Signed: \_\_\_\_\_

Diane Schwanbeck

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Commissioner for Patents  
Post Office Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the final rejections set forth in the Final Office Action dated October 16, 2006. This request is being filed concurrently with a Notice of Appeal.

Claims 1-8 and 10-71 are pending in the subject application. Claims 1, 2, 5-8, 10, 11, 18-21, 26-29, 52-54, 57-65, 67, and 69-71 have been rejected under 35 U.S.C. § 102(b) as being anticipated by *Shiota et al.* (U.S. Patent No. 6,011,547). Claims 3 and 4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shiota* in view of *Liu* (U.S. Patent No. 6,523,046 B2). Claims 12-17, 22-25, 30-36, 47-51, 55, and 56 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shiota* in view of *Telle* (U.S. Patent No. 5,105,266). Claim 37 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shiota* in view of *Telle* and *Liu*. Claims 38-42 and 44-46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shiota* in view of *Kondo* (U.S. Patent No. 6,281,992 B1). Claim 43 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shiota* in view of *Kondo* and *Liu*. Finally, claims 66 and 68 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over *Shiota* in view of *Telle* and *Kondo*.

In the Argument section set forth below, Applicants have pointed out a number of clear errors in the Examiner's anticipation rejection based on the *Shiota et al.* reference. In light of the

five (5) page limit on this paper, Applicants have not presented detailed arguments regarding each and every pending claim. In the event this application proceeds to appeal, Applicants will present additional arguments regarding claims not specifically addressed herein in their Appeal Brief.

### **ARGUMENT**

#### **Argument No. 1: The Anticipation Rejection of Claim 1 is Improper Because the *Shiota et al.* Reference Does Not Disclose an Image Generating Apparatus That Includes Either the Claimed Image Process Control Obtaining Mechanism or the Claimed Storage Mechanism**

Independent claim 1 defines an image data generating apparatus that includes an image data generating mechanism, an image process control information obtaining mechanism that obtains image process control information that designates image process conditions for generated image data at an output apparatus, an output mechanism that outputs the generated image data associated with the obtained image process control information, and a storage mechanism that holds the image process control information. Claim 1 further specifies that the “image process control information obtaining mechanism is configured to obtain said image process control information *from said storage mechanism.*”

The *Shiota et al.* reference discloses an image reproducing method that reproduces digital image data obtained by a digital camera. In this method, digital camera 1 adds recording information to image data, and the recording information and image data are stored as an image file in image server 2. Image reproducing apparatus 3 obtains the image file from image server 2, and uses the recording information to carry out image processing on the image data in the image file. Image reproducing apparatus 3 has the capability of adding an image processing condition to the image file.

In support of the anticipation rejection, the Examiner asserts that image server 2 constitutes the claimed storage mechanism. Applicants respectfully submit that a memory device on image server 2 does not constitute a storage mechanism as defined in claim 1 for at least the reason that image server 2 is separate and distinct from digital camera 1, which is the image data generating apparatus shown by *Shiota et al.* Nevertheless, even if a configuration including a digital camera and a server is deemed to correspond to the image data generating apparatus defined in claim 1, for the following reasons, the *Shiota et al.* reference still does not disclose the subject matter defined in claim 1.

In the configuration shown by *Shiota et al.*, digital camera 1 adds “recording information” to the image data, and the recording information and the image data are stored as image file 7 in image server 2 (see Figure 1 of the *Shiota et al.* reference). Image reproducing apparatus 3 then adds an image processing condition 10 to image data 8 (see column 5, lines 41-59), and this information is stored in image file 7 in image server 2. Thus, in the configuration shown by *Shiota et al.*, it is not digital camera 1 but rather image reproducing apparatus 3 that adds image processing condition 10 to

the image data. As such, the *Shiota et al.* reference does not disclose an image data generating apparatus that adds an image processing condition to image data as in the claimed subject matter.

An image *processing* apparatus (or an image reproducing apparatus as shown in the *Shiota et al.* reference) typically adds an image processing condition to image data. In contrast, in the claimed subject matter, the image data *generating* apparatus adds an image processing condition to image data. The *Shiota et al.* reference, when characterized properly relative to the claimed subject matter, does not disclose an image data generating apparatus that adds an image processing condition to image data as specified in claim 1. Accordingly, claim 1 is patentable under 35 U.S.C. § 102(b) over *Shiota et al.*

**Argument No. 2: The Anticipation Rejection of Claims 18 and 67 is Improper Because the *Shiota et al.* Reference Does Not Disclose the Claimed “Means for Obtaining Image Process Control Information”**

Each of independent claims 18 and 67 recites “means for obtaining image processing control information.” In accordance with 35 U.S.C. § 112, sixth paragraph, this claim language covers the corresponding structure disclosed in the specification (and equivalents thereof) that obtains the image process control information that designates image process conditions for the generated image data at an output apparatus. As disclosed in the specification of the subject application, a digital still camera (DSC) (or a digital video camera (DVC) or a scanner) obtains the image process control information. See Applicants’ specification at page 12, lines 26-28. In contrast, as discussed above, in the *Shiota et al.* reference, the image reproducing apparatus adds the image processing condition to the image data. The DSC shown by *Shiota et al.*, i.e., digital camera 1, merely adds “recording information” to the image data. It is plain from the discussion in the *Shiota et al.* reference that the recording information is different from the image processing condition added to the image data by the image reproducing apparatus (see, for example, column 5, lines 41-67). Thus, a user could not rely on the recording information to carry out image processing that reflects the user’s intention at the time of shooting.

The *Shiota et al.* reference, when characterized properly relative to the claimed subject matter, does not disclose either an image data generating apparatus (claim 18) or an image data processing system (claim 67) that includes the specified “means for obtaining image process control information.” Accordingly, claims 18 and 67 are patentable under 35 U.S.C. § 102(b) over *Shiota et al.*

**Argument No. 3: The Anticipation Rejection of Claim 52 is Improper Because the *Shiota et al.* Reference Does Not Disclose the Claimed “Means for Retrieving Said Image File from an Image Data Generating Apparatus and Providing the Image File to the Processor”**

Independent claim 52 recites “means for retrieving said image file from an image data generating apparatus and providing the image file to the processor.” Claim 52 further specifies that

the image file includes image data and image process control information that designates image process control conditions for the retrieved image data at an output apparatus.

As discussed above, the image data generating apparatus shown by *Shiota et al.*, i.e., digital camera 1, does not add an image processing condition to the image data. As such, the *Shiota et al.* reference necessarily does not disclose the “means for retrieving” specified in claim 52. Accordingly, claim 52 is patentable under 35 U.S.C. § 102(b) over *Shiota et al.*

**Argument No. 4: The Anticipation Rejection of Claims 57, 61, and 62 is Improper Because the *Shiota et al.* Reference Does Not Disclose an Image Data Generating Apparatus that Adds Image Process Control Information to the Image Data**

Independent claim 57 defines a method that includes, among other steps, “retrieving said image data and image process control information *from an image data generating apparatus.*” Independent claim 61 defines a propagated data signal for conveying image data and image processing control data, and specifies that the image process control information is *provided by the image data generating apparatus.* Independent claim 62 defines a computer program product that includes computer code “configured to retrieve image data and image process control data associated with the image data *from an image data generating apparatus.*”

As discussed above, the image data generating apparatus shown by *Shiota et al.*, i.e., digital camera 1, does not add an image processing condition to the image data. As such, the *Shiota et al.* reference necessarily does not disclose the above-discussed features of claims 57, 61, and 62. Accordingly, claims 57, 61, and 62 are patentable under 35 U.S.C. § 102(b) over *Shiota et al.*

**Argument No. 5: The Anticipation Rejection of Claim 71 is Improper Because the *Shiota et al.* Reference Does Not Disclose A Digital Still Camera Having the Claimed Features**

Claim 71 defines a digital still camera that includes, among other features, an image process control information obtaining module that obtains image process control information. In support of the anticipation rejection, the Examiner asserts that image server 2 (see Figure 1 of the *Shiota et al.* reference) constitutes the claimed image process control information obtaining module. Contrary to the Examiner’s characterization of the *Shiota et al.* reference, however, image server 2 is separate and distinct from digital camera 1. As discussed above, digital camera 1 shown by *Shiota et al.* merely adds recording information to the image data. Given that image reproducing apparatus 3 adds an image processing condition 10 to the image data (see column 5, lines 41-59), it is clear that the recording information shown by *Shiota et al.* is different from an image processing condition. As such, the *Shiota et al.* reference does not disclose a digital still camera that includes an image process control information obtaining module as specified in claim 71. Accordingly, claim 71 is patentable under 35 U.S.C. § 102(b) over *Shiota et al.*

**The Obviousness Rejections Under 35 U.S.C. § 103(a) Based on the *Shiota et al.* Reference in Combination with Various Secondary References**

As noted above, the Examiner has entered several obviousness rejections based on the *Shiota et al.* reference in combination with various secondary references, namely the *Liu*, *Telle*, and *Kondo* references. None of these secondary references cures the above-discussed deficiencies of the *Shiota et al.* relative to the claimed subject matter. Accordingly, the combination of *Shiota et al.* in view of any one or all of the secondary references does not raise a *prima facie* case of obviousness against the claimed subject matter.

**Conclusion**

For the reasons set forth above, the anticipation rejection of the claimed subject matter is improper because it is not based on a reasonable characterization of the *Shiota et al.* reference relative to the claimed subject matter. When properly characterized relative to the claimed subject matter, the *Shiota et al.* reference does not disclose each and every feature of the claimed subject matter. Further, none of the secondary references cures the deficiencies of the *Shiota et al.* reference relative to the claimed subject matter. Accordingly, the *Shiota et al.* reference taken in combination with any one or all of the secondary references does not raise a *prima facie* case of obviousness against the claimed subject matter.

In view of the foregoing, Applicants respectfully submit that claims 1-8 and 10-71 are in condition for allowance. Accordingly, a notice of allowance is respectfully requested. In the event a telephone conversation would expedite the prosecution of this application, Applicants' undersigned representative may be reached at (408) 749-6902. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees to Deposit Account No. 50-0805 (Order No. MIPFP005).

Respectfully submitted,  
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